REMARKS/ARGUMENTS

Claims 77-118 are pending in the application. Claims 77-115 have been canceled without prejudice or disclaimer and not in response to any prior art issue, but rather to take up method claims first. We reserve the right to file a divisional application on the subject matter of 77-115. Claims 116-118 have amended solely to clarify some aspects, and not in response to prior art issues or to alter the scope. New claims 119-130 have been added. No new matter has been added. Reconsideration of the claims is respectfully requested.

CLAIM REJECTIONS - 35 U.S.C. §102

On page 2 of the Office Action, claims 77-81, 105-107, 109-112 and 115 are rejected under 35 USC § 102(e) as being anticipated by U.S. Patent 6,305,802 ("Roffman"). Claims 77-81, 105-107, 109-112 and 115 are cancelled without prejudice or disclaimer.

On page 2 of the Office Action, claims 82-87, 94-96, 100, 108 and 116-118 are rejected under 35 U.S.C. §102 (e) as being anticipated by U.S. Patent No. 6,095,651 ("Williams"). Claims 82-87, 94-96, 100 and 108 are cancelled without prejudice or disclaimer. The Applicant asserts that claims 116-118 and new claims 119-130 are not anticipated by Williams.

Before even getting to the detailed arguments about the substance of the Williams reference, it is essential to realize that Williams is an apparatus that provides for improved imaging of a patient's eye and does not remove the lens to operate. Therefore, its applicability as a teaching reference is severely handicapped by the inventor's objectives which permeate that disclosure. At best then, Williams is a specific disclosure of the following: a system in which a beam strikes a deformable mirror before entering the eye. The beam reflects off the retina, reflects off the deformable mirror, and is monitored by a Hartmann-Shack wavefront sensor on a CCD array. By adjusting the deformity of the (external) mirror, the aberrations in the eye may be compensated for,

resulting in improved vision for the eye, and improved resolution for a system that forms an image of the retina. Notice that Williams is directed to a total wavefront measurement of an eye but does not deal with corneal topography per se in and of itself.. Consequently, to apply Williams as a sec. 102 or 103 reference requries a dramatic expansion of its disclosure and a radical departure from the intent of the document.

For patients having cataracts, where the eye's natural lens becomes opaque, measurements cannot be taken through the eye's natural lens. The removal of the eye's natural lens, and measurements taken on the eye without the natural lens, are therefore important steps for correcting the vision of these patients – none of which is taught by Williams.

Williams fails to disclose "measuring the aberrations of the eye not comprising the lens ...", as recited by independent claim 116. Measurements in Williams are only taken with the natural lens intact. For instance, Williams states, "The lens of the eye 100 focuses the laser beam on its retina." (column 4, lines 33-34).

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102. Applicants respectfully submit that Williams does not teach every element of claim 116, and therefore fails to anticipate claim 116.

Dependent claims 117-118, which are dependent from independent claim 116, were also rejected under 35 U.S.C. §102(e) as being unpatentable over Williams. While Applicants do not acquiesce with the particular rejections to these dependent claims, it is believed that these rejections are moot in view of the remarks made in connection with

independent claim 116. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent claims 117-118 are also in condition for allowance.

CLAIM REJECTIONS - 35 U.S.C. §103

On page 3 of the Office Action, claims 113 and 114 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Roffman. Claims 113 and 114 are cancelled without prejudice or disclaimer.

On page 3 of the Office Action, claims 88-93, 97-99, 101-104 and 114 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Williams. Claims 88-93, 97-99, 101-104 and 114 are cancelled without prejudice or disclaimer.

CONCLUSION

In view of the amendments and reasons provided above, it is believed that all pending claims are in condition for allowance. Applicant respectfully requests favorable reconsideration and early allowance of all pending claims.

If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicant's attorney of record, Michael B. Lasky at (952) 253-4106.

Respectfully submitted,

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